

R E M A R K S

It is respectfully requested that the Examiner enter and consider the changes made in the claims which are indicated in the Listing of Claims set forth in Appendix I attached to this paper. Accordingly, Claims 10 and 11 are amended to obviate the Examiner's rejection thereof under 35 U.S.C. §112, ¶2.

The Examiner argued that Claims 10 and 11 were indefinite because the limitation "*or the compound of the formula I and at least one compound of the formula II, III or IV as set forth in claim 1*" lacked proper antecedent basis. Accordingly, applicants have revised Claim 10 to set forth the referenced formulae. Additionally, applicants have clarified in Claim 10 that the respective compounds be applied in synergistically effective amounts. The wording of Claim 11 has been revised accordingly. No new matter has been added.

Applicants' amendment seeks to comply with the Examiner's requirement of form expressly set forth in the final action and is, therefore, deemed to fall within the group of acceptable amendments specifically mentioned in 37 C.F.R. §116(a)(1). Favorable action by the Examiner is respectfully solicited.

Additionally, the Examiner rejected Claims 10 and 11 under 35 U.S.C. §112, ¶1, taking the position that the respective claims contained subject matter which lacked support by an adequate written description.

To satisfy the written description requirement, an application must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor(s) had possession of the claimed invention.<sup>2)</sup> An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.<sup>3)</sup> Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of

2) See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

3) *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention.<sup>4)</sup> There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed, and "the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims."<sup>5)</sup>

Claim 10 is drawn to the subject matter of original Claim 7 the only difference being that Claim 10 is in independent form whereas Claim 7 incorporated the features of Claim 6, and indirectly the pertinent elements of Claim 1, by reference. The wording of original Claim 7 clearly conveys to a person having ordinary skill in the pertinent art that applicants' mixtures include quasi "pre-mixed" combinations of the respective compounds in the requisite amounts, as well as combinations which are obtained quasi "in situ" when the requisite amounts of the respective compounds are applied to the target separately either simultaneously or in succession. The equivalence of quasi "pre-formed" and quasi "in situ" formed mixtures is expressed throughout the application:

*Moreover, the invention relates to a method for controlling harmful fungi using mixtures of the compound I with at least one of the compounds II, III or IV and to the use of compounds I, II, III and IV for preparing such mixtures, and to compositions comprising these mixtures.<sup>6)</sup>*

*Moreover, we have found that applying the compound I simultaneously, that is together or separately, with at least one further compound II, III or IV or applying the compound I with at least one of the compounds II, III or IV in succession provides better control of harmful fungi than is possible with the individual compounds alone.<sup>7)</sup>*

The mixtures of the compound I with at least one of the compounds

4) See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406; *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991).

5) *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976).

6) Page 2, indicated lines 10 to 14, of the application.

7) Page 2, indicated line 43, to page 3, indicated line 2, of the application; emphasis added.

II, III and IV, or the compound I and at least one of the compounds II, III and IV applied simultaneously, together or separately, exhibit outstanding activity against a wide range of phytopathogenic fungi, ...<sup>8)</sup>

The compound I and at least one of the compounds II, III and IV can be applied simultaneously, that is together or separately, or in succession, the sequence, in the case of separate application, generally not having any effect on the result of the control measures.<sup>9)</sup>

If phytopathogenic harmful fungi are to be controlled, the separate or joint application of the compound I and at least one of the compounds II, III and IV or of the mixtures of the compound I with at least one of the compounds II, III or IV is effected by ...<sup>10)</sup>

The fungicidal synergistic mixtures according to the invention or the compound I and at least one of the compounds II, III and IV can be formulated, for example, in the form of ...<sup>11)</sup>

The compounds I, II, III and IV, the mixtures, or the corresponding formulations, are applied by treating the harmful fungi, their habitat, or the plants, seeds, soils, areas, materials or spaces to be kept free from them with a fungicidally effective amount of the mixture, or of the compound I and at least one of the compounds II, III or IV in the case of separate application.<sup>12)</sup>

A person of ordinary skill in the art is, at least in light of the foregoing sections, clearly fully apprised of the fact that applicants' disclosure does not distinguish between "pre-formed" mixtures and in situ combinations of the compounds. A person of ordinary skill is, therefore, also fully apprised by applicants' disclosure that the object of the invention "to provide ... (synergistic mixtures),"<sup>13)</sup> is achieved irrespective of whether the respective compounds in the requisite amounts are provided in a "pre-mixed" combination or are combined "in situ" by applying the requisite amounts of the respective

8) Page 5, indicated lines 28 to 31, of the application; emphasis added.

9) Page 6, indicated lines 18 to 22, of the application.

10) Page 7, indicated lines 17 to 21, of the application; emphasis added.

11) Page 7, indicated lines 25 to 27, of the application.

12) Page 8, indicated lines 37 to 43, of the application.

13) Page 2, indicated lines 34 to 37, of the application.

compounds to the target separately either simultaneously or in succession.<sup>14)</sup>

The Examiner argued that the phrases "better control" and "outstanding activity" which are inter alia used on pages 2, 3 and 5 of the application fail to indicate synergistic effects. It is, however, immediately apparent from the context in which those expressions are used in applicants' disclosure that the respective effects are inherent in the combination of the requisite amounts of the respective compounds and are, as such, not dependent on whether the combination takes place in advance or quasi in situ. Accordingly, the "better control" and "outstanding activity" correspond to the "improved activity against harmful fungi combined with a reduced total amount of active compounds applied (synergistic mixtures)." The Examiner's respective position is therefore not deemed to be well taken. Also, the Examiner's position that "[t]he specification does not provide a written description of synergism where the compounds I and II, III or IV are applied separately or successively"<sup>15)</sup> is, in light of the foregoing, deemed to be clearly in error.

It is respectfully urged that the Examiner's arguments are insufficient to establish that a person of ordinary skill in the art would not recognize in the disclosure of the invention which is provided by applicants a description of the invention which was originally defined in Claim 7 and which is now presented in independent form in Claim 10. Accordingly, the rejection of Claim 10 under Section 112, ¶1, should be withdrawn. Claim 11 corresponds to Claim 8 except that Claim 11 depends upon Claim 10 rather than Claim 6. Since the Examiner allowed Claim 8 the elements recited in Claim 11 are, by themselves, not in question, and the arguments regarding the written description supporting the subject matter of Claim 10 also fully apply where the subject matter of Claim 11 is concerned.

Favorable reconsideration of the Examiner's rejection of Claims 10 and 11 under Section 112, ¶1, is respectfully solicited.

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14) Cf. e.g. page 2, indicated line 41, to page 3, indicated line 2, of the application.

15) Office action page 3, lines 13 and 14; cf. also page 3, lines 17 to 20.